

REMARKS

Claim 14 has been amended by this amendment. No new matter has been added.

Claims 1-13, 33-60 and 67-86 were previously withdrawn.

Claims 14, 16-18, 20-24, 26-28 and 30-32 are pending in the application.

Claim Objection

Claims 14, 16-18, 20-24, 26-28 and 30-32 were objected to as the recitation in claim 14 that a thixotropic gel is “located in the container” as being redundant.

Applicants have amended claim 14 to delete the term “located in the container” by this amendment to fully address this objection.

Claims Rejections – 35 USC § 102

Claims 14, 16-18 and 21-32 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,350,593 to Kessler ("Kessler ").

Applicants respectfully traverse this rejection.

Of the claims rejected, claim 14 is independent, with the remaining claims dependent thereon.

Amended claim 14 now recites among other things:

*a thixotropic gel in contact with a portion of the inner wall,
wherein the thixotropic gel comprises continuous first and second regions, the first region located at or adjacent to the lower end, and the second region extending upward from a portion of the first region, wherein the first region comprises an imaginary upper boundary at which the first region exhibits 360° circumferential contact with the inner wall, and wherein the first region comprises at least about 80 vol.% of the thixotropic gel.*

The MPEP section 2131 on Anticipation — Application of 35 U.S.C. 102(a), (b), and (c) [R-1] states: TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053(Fed. Cir. 1987).

Applicants submit that Kessler fails to disclose at least the claimed feature of the first region comprising at least about 80 vol.% of the gel.

The Examiner states in the Office Action dated November 21, 2008:

“Kessler teaches a thixotropic gel 22 located inside at the closed lower end of the container contacting a portion of the inner wall (col. 1, line 56- col. 2, line 2; col. 3, line 54- col. 4, line 6; see also Figs. 2-3). Therefore, since the claimed and prior art gels are identical or substantially identical in structure or composition they must necessarily exhibit the same rheological properties under the same conditions. That is, the first region of the gel of Kessler inherently comprises:
a first region with at least about 80 vol. % of the gel (claim 14),”

Applicants respectfully point out that claim 14 is directed to a specific geometry (and not a composition or structure) for a thixotropic gel disposed in a container which overcomes potential gel movement issues.

According to well-established law, in order for a prior art reference to amount to an inherent anticipation of a claim, all the elements of the claim must necessarily, inevitably and always result from the prior art disclosure; mere possibilities or probabilities are not sufficient. *See Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553-54, 220 U.S.P.Q. 303, 313-14 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 325-26 (C.C.P.A. 1981); *Phillips Petroleum Co. v. U.S. Steel Corp.*, 673 F.Supp. 1278, 1295 n.12, 6 U.S.P.Q.2d 1065, 1076-77 n.12 (D. Del. 1987), *aff'd*, 865 F.2d 1247, 9 U.S.P.Q.2d 1461 (Fed. Cir. 1989); *Hughes Aircraft Co. v. U.S.*, 8 U.S.P.Q.2d 1580, 1583 (Ct. Cl. 1988); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (B.P.A.I. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1987). Quoting *Crown Operations Int'l v. Solutia*, 289 F.3d 1367 (Fed. Cir. 2002) (Emphasis added) :

“Regarding alleged anticipation by the Gillery patent, on its face the Gillery patent does not disclose or discuss a two percent limitation for the reflectance contribution of the solar control film. Crown maintains that the '511 patent merely claims a preexisting property inherent in the structure disclosed in the prior art. Crown urges us to accept the proposition that if a prior art reference discloses the same structure as claimed by a patent, the resulting property, in this case, two percent solar control film reflectance, should be assumed. We decline to adopt this approach because this proposition is not in accordance with our cases on inherency. If the two percent reflectance limitation is inherently disclosed by the Gillery patent, it must be necessarily present and a person of ordinary skill in the art would recognize its presence.”

Thus, it is not sufficient that a teaching of a prior art reference could yield a result that would anticipate the claim against which the prior art reference is applied; instead, to be anticipatory under the doctrine of inherency, the teaching of the prior art reference must inevitably lead to the result.

Kessler is completely silent in regard to the vol% of gel within the first region.

The specific geometry of a gel within a tube is controlled by numerous variables or conditions including for example; the angle of the tube during gel deposition, the temperature of the gel during dispensing, the mechanical history of the gel prior to dispensing, the cooling profile of the gel post dispensing.

Thus Kessler fails to inherently disclose at least the claimed feature of the first region comprising at least about 80 vol.% of the gel.

For these reasons, applicants submit that independent claim 14 and dependent claims 16-18 20-24, 26-28 and 30-32, are not anticipated by the Kessler reference.

Conclusion

In view of the amendment and remarks herein, applicants submit the claims are patentably distinct over the prior art and allowable in form.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 02-1666.

If the Examiner has any questions or comments relating to the present application, he or she is respectfully invited to contact applicants' agent at the telephone number set forth below.

Respectfully submitted,

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Dated: February 20, 2009.
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Doc# 151838v1